



07 AUG 2007

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In re Application of :
KIM, TAE HONG :
Application No.: 10/585,602 :
PCT No.: PCT/KR05/00134 :
Int. Filing Date: 14 January 2005 :
Priority Date: 15 January 2004 :
Attorney Docket No.: 05-507-B :
For: APPARATUS AND METHOD FOR
DUALIZING AN ASYNCHRONOUS
TRANSFER MODE (ATM) ROUTER IN
A CDMA2000 SYSTEM \

DECISION ON PETITION

This decision is in response to applicant's "Renewed Petition under 37 CFR 1.47(b) By Person Having Proprietary Interest to File Application on Behalf of Inventor Who We Have Been Unable to Locate" filed 18 July 2007. The petition fee has been submitted.

BACKGROUND

On 14 January 2005, applicant filed international application PCT/KR05/00134 which claimed a priority date of 15 January 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 01 September 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 15 July 2006.

On 11 July 2006, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a copy of the international search report.

On 16 March 2007, the United States Designated/Elected Office mailed "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required.

On 20 June 2007, applicant filed a petition under 37 CFR 1.47(b). In a decision dated 06 July 2007, applicant's petition under 37 CFR 1.47(b) was dismissed without prejudice.

On 18 July 2007, applicant filed a renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Items (1); (3); (4); and (6) were previously satisfied.

As to Item (2), a review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Tae Hong Kim. The steps taken are sufficient to show that the missing inventor, Tae Hong Kim, could not be reached after diligent effort.

Concerning Item (5), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. MPEP 409.03(f).

Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

The present petition states that the inventor Tae Hong Kim assigned the invention to Hyundai Syscomm, Inc. ("Hyundai") and that Hyundai subsequently assigned the invention to UTStarcomm Korea Limited ("UTStarcomm"). Petitioner has previously demonstrated a transfer of title from Hyundai to UTStarcomm. Furthermore, the renewed petition includes an appropriate legal memorandum from attorney Joo-Young Kim which states that Hyundai would have title to the present invention instead of inventor Kim. Therefore, a chain of time from Tae Hong Kim to UTStarcomm has been sufficiently established.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Tae Hong Kim under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is GRANTED.

The application will be given an international filing date of 14 January 2005 under 35 U.S.C. 363, and a date of 20 June 2007 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(c) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.



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